

Remarks

Status of Claims:

Claims 1-7, 21-34 stand rejected. Claims 1 and 21 are amended. Claim 6 is canceled. Claims 1, 5,7 and 21-34 remain pending.

No new matter is added in amending the claims.

The claim amendments are made without prejudice to applicant filing one or more continuation applications with claims as originally filed or previously presented.

Claim Objection:

Claim 1 is amended to correct the typo noted by the Examiner.

102 Rejections:

Claims 1, 5, 21-23, 30-31, and 33 are rejected as anticipated by Shadduck.

It is respectfully urged that the claims, as amended, distinguish over Shadduck.

Claims 1, 5, 21-23, 30-31, and 33 are rejected as anticipated by Truckai. It is respectfully urged the claims, as amended, distinguish over Truckai.

§ 103 Rejections:

Claims 1, 5-6, and 34 are rejected as obvious over Wardle et al. US2002/0120211 (Wardle) in view of Truckai (6,485,436) or Shadduck. This rejection should be withdrawn for at least the following reasons.

First, there is no motivation in the prior art to combine Wardle with Truckai or Shadduck.

The Examiner's only explanation for combining the references is that, according to the Examiner, Truckai and Shadduck provide analogous biopsy devices.

Even if the Examiner's comment regarding Truckai and Shadduck is assumed for the sake of argument to be true, that is not motivation to modify Wardle with Truckai and/or Shadduck.

This is no more than improper hindsight reconstruction of the Applicant's invention. It is respectfully urged that the Examiner does not meet the Examiner's burden of providing motivation for a prima facie case of obviousness by merely stating a feature is in one patent, and then concluding it would be obvious to modify another patent to have that feature. Using this standard, any two patents could be combined in any fashion imaginable by the Examiner.

Second, if one combined the references as suggested by the Examiner, it is respectfully urged that the resulting combination would not provide, among other things, a connector as recited in amended claims 1 and 21.

The Examiner states Wardle discloses a connector, "best seen in Figure 4". The Examiner is respectfully requested to explain what in Figure 4 is the "connector" so that the Applicant has a full and fair opportunity to respond.

Third, it is respectfully urged that one would also not modify Wardle as suggested by the Examiner, because it would be counter to the very teachings of Wardle. Wardle teaches that cutter 20 is "a distal tip cutter 20", and that the distal tip cutter 20 is used to open a path through which the distal portion 18 of shaft 14 of Wardle's device may be inserted. See first sentence of para 0030 of Wardle:

Distal tip cutter 20 has a cutting surface effective to cut through tissue, *opening up a path* through which distal portion 18 of shaft 14 may be inserted, thus aiding in the placement of shaft 14 within a patient's body. Italics added.

Accordingly, one would not be motivated to move the cutter 20 to have the position suggested by the Examiner, because such a change in design would defeat the very purpose Wardle seeks to accomplish with a distal cutter.

The Examiner acknowledges that Wardle doesn't teach an electrode disposed such that a portion of the electrode is disposed proximally of the distal most portion of the tissue receiving opening, and wherein at least a portion of the electrode is positioned distally of a proximal most portion of the tissue receiving opening, and the modification suggested by the Examiner is not supported by the art cited by the Examiner.

Additionally, the combination of Shadduck and Wardle proposed by the Examiner is contrary to the very teachings of Wardle. In particular, Shadduck shows the electrodes 45 spaced away from the tip 16 of Shadduck. It is respectfully urged that if anything, Shadduck teaches away from the purpose of Wardle of having a distal tip cutter. If one placed the cutter 20 of Wardle as suggested by Shadduck, the cutter 20 would not be in a position to perform the very operation for which Wardle provides cutter 20... -- *opening up a path* through which distal portion 18 of Wardle's shaft 14 may be inserted.

The arguments made in prior responses are maintained, in addition to those arguments included in this response.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

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